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In re Application of :
FINN et al. :
U.S. Application No. 10/534,222 : DECISION ON PETITION
PCT No.: PCT/AU03/01480 :
It. Filing Date: 10 November 2003 :
Priority Date: 08 November 2002 :
Attorney Docket No.: 123-002 :
For: A DISTILLATION UNIT AND A :
METHOD OF DISTILLATION :

This decision is issued in response to applicants' "Renewed Petition under 37 CFR 1.47(a)" filed 27 June 2006 to accept the application without the signature of joint inventor, John Barry Finn.

BACKGROUND

On 10 November 2003, applicants filed international application PCT/AU03/01480, which claimed priority of an earlier application filed 08 November 2002. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 21 May 2004. Pursuant to 37 CFR 1.495, the deadline for payment of the basic national fee in the United States was to expire 30 months from the priority date, 08 May 2005.

On 06 May 2005 applicants filed a transmittal letter for entry into the national stage in the United States, which accompanied by, inter alia: the requisite basic national fee as required by 35 U.S.C. 371(c)(1); a copy of the international application; and an information disclosure statement.

On 21 October 2005, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) must be filed. The notification set a two-month time limit in which to respond.

On 28 October 2005 and 15 December 2005, applicants filed a petition under 37 CFR 1.47(a). In a decision dated 23 February 2006, applicants' petition under 37 CFR 1.47(a) was dismissed without prejudice.

On 27 June 2006, applicant filed the present renewed petition under 37 CFR 1.47(a).

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17, (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and behalf of the nonsigning joint inventor. Items (1), (3), and (4) have been satisfied.

Regarding item (2) above, petitioner states that John Barry Finn has refused to sign the application. Section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.), **Proof of Unavailability or Refusal**, states, in part:

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Proof that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

A review of the present petition reveals that petitioner has not shown that a bona fide attempt was made to present the application papers (specification, claims, drawings, and oath/declaration) to John Barry Finn. The declaration of Phillip Pluck states that John Barry Finn refused to execute the inventor's declaration in a telephone conversation dated 09 June 2006. However, it is unclear from the present petition and accompanying

documents whether John Barry Finn has been presented with a complete copy of the application papers (specification, claims, drawings, and oath/declaration) as required. Lastly, the declarations of Brian Douglas Jenkins and Phillip Pluck fail to provide the circumstances of the presentation of the application papers to John Barry Finn.

As stated above, where a refusal of the inventor to sign the application papers is alleged, a statement of facts is needed from a person having first hand knowledge of the facts that a complete copy of the application papers (specification, claims, drawings, and oath/declaration) were sent to John Barry Finn, and when such papers were sent. In addition, copies of documentary evidence such as a certified mail return receipt, cover letter of instruction, telegrams, etc., should be supplied with the declaration.

For the reasons stated above, it would not be appropriate to accept the application without the signature of John Barry Finn under 37 CFR 1.47(a) at this time.

CONCLUSION

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to: Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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